

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:) Attorney Docket No.: S-215
) Customer No.: 00919
Jean-Marc Alexia, et al.)
) Examiner: JOSEPH, Tonya S.
Serial No.: 10/809,570) Group Art Unit: 3628
Filed: March 24, 2004)
Confirmation # 7997) Date: May 28, 2010

Title: SECURE FRANKING MACHINE

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF ON APPEAL

Sir:

The Appellants respectfully submit this reply brief pursuant to 37 C.F.R. § 41.41 in reply to the Examiner's Answer filed on March 30, 2010 in the appeal of the subject application. The Notice of Appeal was transmitted July 16, 2009 and Appellants' Brief on Appeal was transmitted November 16, 2009. Accordingly, this brief is timely filed. No fee is believed due. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. **16-1885**.

I. Examiner's Answer Section 10, Response to Arguments

Initially, Appellants respectfully submit that the Examiner has not addressed in response each of Appellants' arguments made in Appellants' Brief in sections VII.A through VII.F. Appellants respectfully draw attention to those arguments and submit that they establish that the rejections are in error and should be reversed.

On pages 12-13 of the Answer, the Examiner suggests that Strand '094 is analogous art to Pauschinger '255. The Examiner states:

Paushinger is directed to protecting a device against operation with unallowed printer cartridges, (see the Abstract of Paushinger and Col. 6 lines 31-62) and Strand is related to printer cartridge encryption. Both are concerned with the authentication and security of print cartridges and chambers.

(emphasis added). However, Strand '094 has nothing to do with print cartridges at all and never uses the term "print." In fact, Strand '094 describes only liquid chromatography systems. One of skill in the franking machine printing arts would not look to Strand '094 in order to modify the postage printing system of Paushinger '255. Here, the secondary reference Strand '094 is well outside the field of the primary reference inventors' field of endeavor of postage printing systems and even printing systems generally and therefore would not necessarily logically commend itself to such inventor's attention in considering the problem. *See e.g., In re Icon Health and Fitness, Inc.*, 496 F.3d 1374 (Fed. Cir. 2007).

Accordingly, the Examiner's factual statement is plainly not correct. The Strand '094 reference is not analogous art, one of skill in the art would not make the suggested combination and the rejection should be reversed.

On page 13 of the Answer, the Examiner suggests that the combination with Strand '094 would not render Pauschinger '255 inoperable. However, Paushinger '255 is specifically concerned with restricting printer use to authorized print consumable cartridges, whereas Strand apparently does not check for authorized printer cartridges,

but instead deals with fluid testing and test data encryption such that the proposed combination would appear inoperable.

On pages 14-15 of the Answer, The Examiner apparently admits that the cited references do not teach or fairly suggest the following elements:

means for encrypting the signature of the franking data by the data generating unit using an encryption key determined using the obtained data that enabled identification and authentication of the print member,

means for sending the franking data and the encrypted signature to the printing unit in a second communication mode and for including a control signal with printing control signals.

The Examiner suggests on page 15 that printing and envelope (Pauschinger '704 at Col. 7, ll. 54-59) is a second communications mode, but it certainly could not be a second communications mode to communicate to the printing unit. The Examiner does not apparently address the element: "using an encryption key determined using the obtained data that enabled identification and authentication of the print member."

On page 15 of the Answer, the Examiner again suggests that Hetzer '755 plainly describes print control signals. However, contrary to the Examiner's assertion, Hetzer '755 does not teach or suggest including control signals, but only print data signals. The Examiner cites to Paragraph 34 of Hetzer '755, but the description found there apparently only describes print data signals. Accordingly, the rejection should be reversed.

On page 16 of the Answer, the Examiner refused to afford patentable weight to elements that define structure. With regard to claims 22 and 44, Appellants respectfully submit that the positively recited elements referenced must be afforded patentable weight and is not taught or fairly suggested in the prior art.

Claims 22 and 44 recite:

22. A franking machine according to claim 19, wherein the print member includes at least one tag identifying said print member which communicates data identifying said member to the data generating unit by radio waves when an electromagnetic field is applied to it.

44. A franking machine according to claim 19, wherein the print member includes at least one tag identifying said print member and wherein the tag is permanently attached to the print member such that attempting to remove the tag will render it inoperative.

Contrary to the Examiner's assertion, the claim elements provide structure. Moreover, even if the cited language used functional language to describe the structure claimed, functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971); MPEP 2173.05(g). Accordingly, the rejection should be reversed.

Similarly, on page 16 of the Answer, the Examiner apparently does not afford patentable weight to positively recited elements. Claims 28-29 recite:

28. A franking machine according to claim 19, wherein the decrypting means are fixed to a thin and flexible printed circuit that is fixed to the print member, wherein the printed circuit is sufficiently flexible to bend easily and sufficiently thin to be installed on a standard inkjet printer cartridge without compromising installation of the cartridge in a standard inkjet printer associated with the cartridge.

29. A franking machine according to claim 27, wherein the data processing unit is fixed to a thin and flexible printed circuit that is fixed to the print member, wherein the printed circuit is sufficiently flexible to bend easily and sufficiently thin to be installed on a standard inkjet printer cartridge without compromising installation of the cartridge in a standard inkjet printer associated with the cartridge.

Accordingly, the rejection should be reversed.

On pages 16-17 (and 9) of the answer, the Examiner does not provide a rationale for the proposed combination of 6 references against claim 23 that suggest anything other than improper hindsight reasoning. The Examiner is impermissibly using hindsight and the Appellants disclosure to piece together six non-analogous references without providing a basis for doing so. In the absence of an articulated rationale to combine, the rejection should be reversed.

Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 19-44 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted on behalf of Appellants,

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